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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,907	07/11/2001	Veronique Guillou	210231US0	7859

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

17

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,907

Applicant(s)

GUILLOU ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of response filed on March 17, 2003. Claims 1-23 are pending. The claim rejections under 35 U.S.C. § 103 indicated in the previous Office action dated December 17, 2002 are withdrawn in view of applicants' remarks. New rejections are made in view of further consideration.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lukenbach (US 6090773) ("Lukenbach") in view of Derian et al. (US6262130 B1) ("Derian").

Lukenbach teaches a conditioning shampoo or body cleanser composition comprising cationic polymers, an amphoteric surfactant, anionic surfactant, and a nonionic surfactant. See col. 1, line 34 – col. 2, line 59. Amphoteric and anionic phosphate surfactants are disclosed in col. 6, line 56 – col. 10, line 46. The example formula in Table 7 comprises 3.6 % by weight of sodium lauroampho PG-acetate phosphate, acrylamidopropyltrimonium chloride acrylamide copolymer, acrylates/steareth-20 methacrylate copolymer, and polyquaternium-10. Decyl glucoside, a nonionic surfactant, is used in the amount 3.6 % by weight. See instant claims 5-12, 14. While the "foam height" of the prior art is not explicitly discussed, examiner takes the position that, a composition comprising the same foaming nonionic surfactant used in the instant invention would produce similar foaming property that is within obvious range of

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the instant claims. The reference teaches that polyquaternium-10 and polyquaternium-7 are preferred conditioning polymers. See col. 10, line 57 – col. 12, line 37; instant claims 13, 16, and 23. The formula also contains glycerin. See also col. 14, line 44 – col. 15, line 2; instant claim 17. The reference further teaches using thickening agents. See col. 14, lines 4 – 27; instant claim 18. The claimed method of using the composition is viewed an expected use of an obvious variation of the prior art. See instant claims 19-22.

While the Lukenbach invention employs cationic polymers containing saccharide such as polyquaternium-10 and guar hydroxypropyl trimonium chloride, the reference teaches that polyquaternium-7 or polyquaternium -6, (cationic polymers devoid of saccharide) are equivalency to these polymers. It is well settled in patent law that it is prima facie obvious to substitute equivalents known for the same purpose. See MPEP § 2144.06. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted polyquaternium 10 and guar hydroxypropyl trimonium chloride, with polyquaternium-7 and/or polyquaternium –6 because of the expectation of successfully producing a cleansing composition with similar conditioning effects.

Lukenbach generally teaches alkyl phosphate surfactants, disclosed in col. 10, lines 16 – 42. The reference fails to teach using the specific phosphate surfactants of the instant claims 4 and 16.

Derian teaches aqueous surfactants comprising alkyl phosphate ester salts useful in formulating flowable or pumpable transparent gels. See abstract; col. 1, line 19 – col. 2, line 55. Potassium salt of dodecyl phosphate is disclosed.

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See instant claims 4 and 16. The reference teaches that the alkyl phosphate ester salts are useful in cosmetic and personal care products because of their foaming properties, detergency, non-irritating properties, form density, stability and skin feel. The reference also teaches that the invention does not require the presence of such undesirable other surfactants or large amounts of co-solvents or alcohols or other additives. See col. 2, lines 26 – 36. The invention, which is pumpable and transparent, is also said to allow minimize the amount of co-solvents or other surfactants. See col. 3, line 10 – col. 4, line 44. Although both references are silent as to the measurement of the actual foam height of the inventions, examiner takes the position that, in view of the fact that prior art which meet the limitations of the instant claims, the claimed properties of the instant inventions may be due to the limitations not disclosed in the instant claims.

Given the general teaching of using phosphate surfactants in Lukenbach, it would have been obvious to one of ordinary skill in the art at the time the invention was made to look to the prior art such as Derian for specific phosphate surfactants. The motivation to have modified the Lukenbach composition by substituting the anionic surfactants with the phosphate surfactants of Derian would have been obvious to the skilled artisan because of the expectation of successfully producing a transparent cleansing composition with good foaming properties, detergency, non-irritating properties while minimizing the need of co-surfactants.

The term “consisting essentially of” is treated same as “comprising” in absence of applicants’ showing that the presence of the unrecited components

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would materially alter the basic and novel characteristic of the claimed invention.

See PPG Industries v. Guardian Industries, 156 F.3d 1351, 1355, 48 U.S.P.Q. 2d 1351, 1355 (Fed. Cir. 1998).

Response to Arguments

Applicant's arguments with respect to claims 1-23, filed on March 17, 2003, have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments filed on October 2, 2002 also have been fully considered but they are not persuasive.

Applicants argue that the presence of the Lukenbach surfactants not recited in the instant claims is "expected to materially alter the novel and basic properties of the cleansing composition of the invention". Examiner reiterates the holding of the PPG court that, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". Examiner further notes that if applicants contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicants' invention. See In re De Lajarte 337 F.2d 870, 143 U.S.P.Q. 256 (C.C.P.A.) 1964; see also Ex parte Hoffman, 12 U.S. P.Q. 2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989). In this case, examiner views that there is no clear indication in the specification or the claims that the basic and novel characteristics of the present invention actually are the combination of the recited surfactants only. Examiner takes the position

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that applicants bears the burden of showing, with clear and convincing evidence, that the presence of the surfactants not recited in the instant claims somehow materially alters the novelty of the present invention.

Applicants state that there may be a suggestion in Derian to substitute the Lukenbach phosphate surfactant or the surfactant combination with the alkyl phosphate ester. Applicants however assert that such a substitution overcomes none of the many difficulties in attempting to hold the obviousness rejection over Lukenbach. In response, examiner notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, examiner views that the disclosed advantage of the Derian phosphate surfactants (e.g., non-irritating properties and minimizing the need of co-surfactants) would have reasonably provided sufficient motivation to a skilled artisan to use the specific alkyl phosphate esters.

Examiner fully considered the declaration filed on October 2, 2002, but views that the data therein does not render the instant claims in condition for allowance. The declaration provides comparison data between two surfactant compositions comprising polyquaternium-10 and polyquarternium-7. The data shows that the composition comprising polyquarternium-7 provides more viscosity and better rinsing. Examiner notes that the Lukenbach reference

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clearly teaches that polyquaternium-10 and polyquarternium-7 are equivalents which may be substituted for each other as a hair conditioner. In view of Lukenbach, examiner takes the position that obtaining different rheology by using a different compound is not an unexpected result. Furthermore, even if the data showed greater than expected result, examiner views that the data does not reasonably represent the full scope of the claimed invention. The data shows the comparison between polyquaternium-10 and polyquarternium -7 only, while the claimed invention encompasses all "cationic polymers devoid of saccharide groups". The data is not commensurate with the scope of the invention.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

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Gina C. Yu
Patent Examiner
June 2, 2003



SREENI PADMANABHAN
PRIMARY EXAMINER

6/2/03